

REMARKS

Re-examination and reconsideration of the application identified in caption, pursuant to and consistent with 37 C.F.R. §1.112, and in light of the remarks which follow are respectfully requested.

Claims 1-13 remain pending in this application with claim 13 being withdrawn from consideration as not readable on the elected invention.

Claims 1-7, 10 and 12 stand rejected under 35 U.S.C. §103(a) as being obvious over Japanese Patent Document No. 09-039420 (*Usui*) in view of U.S. Patent No. 6,113,679 (*Adkins et al.*) for the reasons set forth on pages 3-4 of the Office Action. Applicants note that the Examiner apparently intended to reject claims 8 and 9 over the foregoing combination but unintentionally omitted such claims from the list of rejected claims. In this regard, the rejection of claims 8 and 9 is discussed at page 3 of the Official Action. Claim 11 stands rejected under §103(a) as being obvious over *Usui* in view of *Adkins et al.*, and further in view of U.S. Patent No. 5,180,264 (*Kojima et al.*) for the reasons set forth on page 4 of the Office Action. These rejections should be withdrawn for at least the following reasons.

The present invention resides in a method of forming an image-recorded material which is prepared by an ink jet recording process. The method provided an image-recorded material having excellent image quality, stability and weather resistance. The method of the invention is designed to overcome previous problems associated with the use of water-soluble or oil-soluble dyes or pigments in ink jet recording processes.

JP '420 (*Usui*) is directed to a method for overcoming problems associated with sublimated hot printing methods. According to paragraph [0003] of the translation: "The purpose of this invention is forming a protective layer in the picture front face formed by the hot printing method ... ". Paragraph [0002] of the translation discusses the problems associated with sublimated-type hot printing methods. These concerns are not related to problems associated with ink jet recording processes which use water-or-oil soluble dyes or pigments.

As the Examiner has noted, JP '420 does mention "ink-jet material" in the list of various recording materials mentioned at the end of paragraph [0004] of the translation. However, this appears to be the only mention of ink-jet recording material in the entire disclosure. The Abstract and working examples are specifically directed to a hot printing method.

Adkins et al. '679 relates to piezo inkjet inks and methods of making and using these inks. This reference is relied upon in the rejection for its disclosure that images formed using thermal inkjet inks are typically provided with a protective clear coating or a laminated film (column 2, lines 39-44). The invention in *Adkins et al.* '679 is designed to eliminate the use of a clear coat or laminated film (column 3, lines 45-47).

To establish a *prima facie* case, the prior art relied upon, coupled with the knowledge generally available in the art at the time of the invention, must contain some suggestion or incentive that would have motivated the skilled artisan to modify a reference or to combine references. See Karsten Mfg. Corp. v. Cleveland Gulf Co., 242 F.3d 1376, 1385, 58 U.S.P.Q. 2d 1286, 1293 (Fed. Cir. 2001) ("In holding an invention obvious in view of a combination of references, there must be some suggestion, motivation, or teaching in the prior art that would

have led a person of ordinary skill in the art to select references and combine them in the way that would produce the claimed invention."); C.R. Bard, Inc. v. M3 Sys., Inc., 157 F.3d 1340, 1352, 48 U.S.P.Q. 2d 1225, 1232 (Fed. Cir. 1998) (a showing of a suggestion, teaching, or motivation to combine the prior art references is an "essential evidentiary component of an obviousness holding"). Northern Telecom v. Datapoint Corp., 908 F.2d 931, 934, 15 U.S.P.Q. 2d 1321, 1323 (Fed. Cir. 1990) (It is insufficient that the prior art disclosed the components of the patented device, either separately or used in other combinations; there must be some teaching, suggestion, or incentive to make the combination made by the inventor."). The teachings or suggestions, as well as the second requirement, expectation of success, must come from the prior art, not applicant's disclosure. See In re Vaeck, 947 F.2d 488, 493, 20 U.S.P.Q.2d 1438, 1442 (Fed. Cir. 1991).

Moreover, the proposed modification of the prior art must have had a reasonable expectation of success, determined from the vantage point of the skilled artisan at the time the invention was made. In other words, a hindsight analysis is not allowed.

Applicants respectfully submit that the respective teachings of these two references represent only isolated disclosures with no suggestion or incentive therein that would have motivated those of ordinary skill to combine their respective teachings and arrive at the method set forth in the present claims. Nor was there a reasonable expectation that applying the method of JP '420 to inkjet recordings would successfully overcome the problems associated with using water-based inkjet inks in view of the fact that the process of the JP reference is directed toward eliminating problems associated with sublimated hot printing methods.

The data set forth in the present specification reflects the unexpected nature of the present invention. Even assuming, *arguendo*, that those of ordinary skill would have been motivated to apply the method of JP '420 to image-recorded materials prepared by an ink jet recording process, one could not reasonably predict that the presently claimed method would overcome prior art problems associated with ink jet recording processes and provide imaged materials having excellent water resistance, excellent image quality (i.e., light and heat fastness), no gloss unevenness and no bronzing. Note the discussion on page 148, for example.

For at least the above reasons, Applicants respectfully submit that the combined disclosures of JP '420 and *Adkins et al.* '679 do not establish a *prima facie* case of obviousness in accordance with 35 U.S.C. §103(a). Accordingly, this rejection should be withdrawn and such action is earnestly requested.

Kojima et al. '624 has been applied in connection with the rejection of claim 11. This reference relates to the preparation of an improved ink jet recording paper. *Kojima et al.* '624 does not disclose the formation of a protective layer on the ink jet recorded image. Accordingly, this reference fails to supply the deficiencies in the basic combination of JP '420 and *Adkins et al.* '679 as enumerated above.

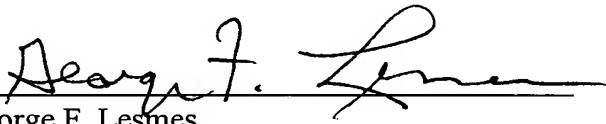
For at least the above reasons, it is apparent that no *prima facie* case of obviousness exists. Accordingly, withdrawal of the §103(a) rejections is respectfully requested.

From the foregoing, further and favorable action in the form of a Notice of Allowance is believed to be next in order, and such action is earnestly solicited.

If there are any questions concerning this paper or the application in general, the Examiner is invited to telephone the undersigned.

Respectfully submitted,

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